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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,588	01/12/2004	Chris J. Diederich	USCF00-066-2	3148
8156	7590	07/24/2007		
JOHN P. O'BANION O'BANION & RITCHEY LLP 400 CAPITOL MALL SUITE 1550 SACRAMENTO, CA 95814			EXAMINER TRUONG, KEVIN THAO	
			ART UNIT 3734	PAPER NUMBER
			MAIL DATE 07/24/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

ED

<b>Office Action Summary</b>	<b>Application No.</b> 10/756,588	<b>Applicant(s)</b> DIEDERICH ET AL.	
	<b>Examiner</b> Kevin T. Truong	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 64-92 is/are pending in the application.
- 4a) Of the above claim(s) 68, 69, 82 and 83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 64-67, 69-81, and 84-92 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

***Note: This is in response to an amendment filed 05/07/2007.***

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 64-67, 69-81, and 84-92 are rejected under 35 U.S.C. 102(b) as being anticipated by Swaminathan (U.S. 6,517,533).

Swaminathan discloses in figure 10, a method for treatment of the prostate gland as recited in the claims as follows: placing the distal end of a catheter (90) between the rectum and the prostate gland; inflating a balloon (98) mounted on the distal end of the catheter (90) between the prostate gland and the rectal wall, wherein the balloon includes a sensor (106) for sensing and monitoring the temperature of the rectal wall and the surface of the prostate gland during the treatment of the prostate gland as well as fluid within the balloon (98) (see col. 6, line 32 thru col. 8, line 20); and furthermore, circulating and replacing fluid through lumens (96,100,108) below or higher normal body temperature during the treatment of the prostate gland by thermotherapy.

3. Claims 64-67, 69-81, and 84-92 are rejected under 35 U.S.C. 102(b) as being anticipated by Dann et al. (U.S. 5,899,932).

Dann et al discloses in figures 2-11, a method for treatment of the prostate gland as recited in the claims as follows: placing the distal end of a catheter (32) between the rectum and the prostate gland; inflating a balloon (34) mounted on the distal end of the catheter (32) between the prostate gland and the rectal wall, wherein the balloon includes a sensor (71) for sensing and monitoring the temperature of the rectal wall and the surface of the prostate gland during the treatment of the prostate gland as well as fluid within the balloon (34); and furthermore, circulating and replacing fluid through lumens (64A,64B,66A,66B) below or higher normal body temperature during the treatment of the prostate gland by thermotherapy.

***Response to Arguments***

1. Applicant's arguments filed 05/07/2007 have been fully considered but they are not persuasive. In response to applicant's argument that Swaminathan and Dann references fail to teach or suggest placing the distal end of catheter (90) (32) in space between the rectum and the prostate gland and inflating the balloon (98) (34) to displace the prostate from the rectal wall and to displace the target tissue from the non-targeted tissue, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As to amended claim 72, Swaminathan disclosed the step of circulating and replacing fluid through lumen (96,100,108) higher normal body temperature during treatment in which capable of

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being heated the prostate gland as recited in the claim. At least for this reason, the Examiner disagrees with Applicant's remarks and has maintained the grounds of rejection under 35 U.S.C. 102 (b) as being anticipated by Swaminathan '533 and Dann et al. '932 for the same reasons as set forth in the previous office action.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

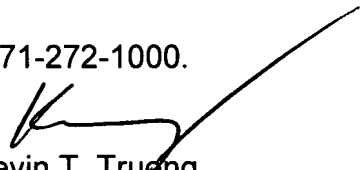
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin T. Truong whose telephone number is 571-272-4705. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on 571-272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kevin T. Truong  
Primary Examiner  
Art Unit 3734

ktt